

## REMARKS

Claims 9, 15 and 21-32 are pending in this application. Attached hereto is a complete listing of all claims in the application, with their current status listed parenthetically. By this Response, claims 15, 22, 26 and 30 have been amended.

### Rejections Under 35 U.S.C. § 102(b) and § 103(a)

In paragraphs 3-5 Office Action, claims 9, 15 22, 25-26 and 28 stand rejected as anticipated by, or obvious over U.S. patent 5,850,539 ("Cook"). Applicant traverses the rejection.

### Rejection Under 35 U.S.C. § 102(b)

The Examiner states on page 3 of the Office Action:

"It should be noted that Cook explicitly teaches his system is designed to *facilitate in the production of* the apparatus. The Examiner finds that *the apparatus whose production is facilitated* anticipates the above noted claims because Cook teaches that the purpose of his invention is to facilitate and design the apparatus *and* aid its production. However, should it be determined that Cook fails to actually teach the apparatus itself, it cannot be disputed that Cook teaches a system and method to facilitate its design" (*emphasis in original*)

Applicant agrees with the Examiner that Cook "fails to actually teach the apparatus itself" as Cook teaches an "automated system **for facilitating creation of** a rack-mountable component personal computer" (Abstract). In addition, as discussed below, Cook fails to teach every element as recited in Applicant's claims. Therefore, Applicant respectfully submits that the Section 102(b) rejection of the claims is traversed.

### Rejection Under 35 U.S.C. § 103

The above-listed claims also stand rejected as obvious over Cook. Applicant traverses the rejection.

## A. The Law of Obviousness

The Supreme Court recently reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:

- (a) **determining the scope and contents of the prior art;**
- (b) **ascertaining the differences between the prior art and the claims in issue;**
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Applicant submits that the Examiner's analysis may have been incomplete when he "ascertained the differences between the prior art and the claims in issue" and that his "determination of the scope and contents of the prior art" may also be inaccurate. Applicant has carefully reviewed the cited Cook reference and submits that a close examination reveals significant differences between Cook and Applicant's claims.

Specifically, regarding claim 15, the Examiner states that Cook teaches:

"... a control module (e.g., **keyboard/monitor/mouse switch box 1410**; see at least figs. 14-15 and 7:53-55) communicating with the video monitor and comprising an arcade control for a video game (e.g., keyboard 1010; see at least fig. 11), **the control module structured to be compatible for use with a plurality of different video game systems (e.g., servers installed in the rack).**"

Similarly, regarding claim 9, the Examiner states:

"Cook teaches a switching system (e.g., **keyboard/monitor/mouse switch box 1410**; see at least figs. 14-15 and 7:53-55) **structured to allow a user to select which of the plurality of different video game systems are to be operated.**"

Also, regarding claim 22, the Examiner states:

"Cook teaches a video game control system comprising; at least one controller (e.g., keyboard 1010); and a control device (e.g., **keyboard/monitor/mouse switch box 1410**) interconnected to the controller, by which operation of the video game control system may be controlled **to play selectively from at least two different video game systems** (see at least 7:53-55)."

Regarding claim 26, the Examiner states:

"Cook teaches an apparatus, comprising: a control module (e.g., keyboard 1010) comprising an arcade control (e.g., respective buttons on

keyboard), the control module structured to be compatible for use with a plurality of different game systems (see at least 7:53-55)."

First, Applicant notes that "keyboard/monitor/mouse switch box 1410" is a computer ICON, not an actual physical device:

"Turning now to FIG. 14, illustrated is a view of the configuration window 200 of FIG. 2, showing, in particular, a keyboard/monitor/mouse switch box submenu 1400 and selection of a chosen keyboard/monitor/mouse switch box 1420. **A keyboard/monitor/mouse switch box 225 provides the mechanism for making the connections for the three devices.** The keyboard/monitor/mouse switch box submenu 1400 displays alternatives available to the user for the keyboard/monitor/mouse switch box 225. When the user clicks on the alternative within the keyboard/monitor/mouse switch box submenu 1400, **a keyboard/monitor/mouse switch box icon 1410** representing the chosen keyboard/monitor/mouse switch box 1420 is graphically displayed in the component graphic area 230 of the configuration window 200 and the component data of the chosen keyboard/monitor/mouse switch box 1420 appears in the component characteristic area 240 of the configuration window 200." (11:17-32)

Clearly, a computer icon 1410 is not an actual physical device as claimed by Applicant. In addition, Cook teaches that the "keyboard/monitor/mouse switch box 225 **provides the mechanism for making the connections for the three devices**" (i.e., the keyboard, the monitor and the mouse). Therefore, the keyboard/monitor/mouse switch box 225 does **not** allow switching between **different video game systems**, as recited in Applicant's claim 9.

Cook 7:53-55, cited by the Examiner, reads as follows:

"The rack limit rules indicate, in pertinent part, that if a UPS 228 is installed, its output rating may not be exceeded. Finally, the required parts rules specify the guidelines for completing the rack-mountable PC. For example, when using the keyboard/monitor/mouse switch box 225 a central processing unit ("CPU") to switch cable is included for each **server 213.**"

The Examiner then argues that a server 213 is equivalent to a PC and a "video game system:"

"The Examiner notes that the server computers are "video game systems" according to the scope of the instant claims (e.g., describing a PC computer as a video game system, further discussed below) because the server computers are useful for playing video games. It is further noted that the terms "server" and "PC" **are used interchangeably in Cook.**

Applicant notes that the terms "server" and "PC" **are NOT used interchangeably** in Cook. Instead, Cook specifically defines each device:

"As used herein, "system" refers to the combination of the general purpose computer and software of the present invention employed to aid a user in the selection of components for a rack-mountable PC. **The terms "rack-mountable PC", "computer" or "PC" refer to the computer being designed.**" (3:34-40)

"Server" is defined in Cook as follows:

"A server 213 is typically a large minicomputer assigned to handle extensive calculations, file management, or other functions **for a group of computers in a network.**" (9:47-49)

Therefore, Cook teaches that a PC (or a "rack-mountable PC" or a "computer") is a computer that is designed using his software, which is for designing rack-mountable servers (1:38-40).

Finally, to further distinguish Applicant's claimed invention from Cook, Applicant has amended independent claims 15, 22, 26 and 30 to specifically exclude "servers," and adopts Cook's definition of a "server" as "a large minicomputer assigned to handle extensive calculations, file management, or other functions **for a group of computers in a network.**"

Applicant respectfully submits that the above-described amendments and the accompanying response has traversed the rejection of independent claims 15, 22, and 26. Claims 9, 25 and 28 depend from one of independent claims 15, 22 or 26, and accordingly it is respectfully submitted that the rejection of claims 9, 25 and 28 has been traversed by virtue of their dependency from one of independent claims 15, 22 or 26. See M.P.E.P. § 2143.03.

## **2<sup>nd</sup> Rejection Under 35 U.S.C. § 103(a)**

In paragraph 6 of the Office Action, claims 23-24, 27 and 30-31 stand rejected as unpatentable under 35 U.S.C. § 103(a) over Cook and the following statement from the Examiner:

"Cook lacks in explicitly teaching that a Macintosh computer system may be used. Regardless, a Macintosh computer lacks criticality in the invention and would have been an obvious matter of choice, well within the capabilities of one of ordinary skill in the art at the time of invention. Furthermore, one of ordinary skill in the art at the time of invention would have recognized that users could benefit by having a Macintosh computer installed in the rack system of Cook in order to provide the use of proprietary or otherwise Macintosh-only programs and functionalities that were not available on a PC type computer."

Applicant traverses the rejection. As discussed above, to further distinguish Applicant's claimed invention from Cook, Applicant has amended independent claim 30 to specifically exclude "servers," and adopts Cook's definition of a "server" as "a large minicomputer assigned to handle extensive calculations, file management, or other functions **for a group of computers in a network.**"

Applicant submits that the above-described amendment and the accompanying response has traversed the rejection of independent claim 30. As claims 23-24, 27 and 31 depend from one of independent claims 15, 22, 26 or 30, it is submitted that the rejection

of claims 23-24, 27 and 31 has been traversed by virtue of their dependency from one of independent claims 15, 22, 26 or 30. See M.P.E.P. § 2143.03.

In paragraph 7 of the Office Action, the Examiner also rejects claims 21, 29 and 32 as unpatentable under 35 U.S.C. § 103(a) over Cook in view of U.S. patent 6,151,645 to Young ("Young").

Claims 21, 29 and 32 depend from one of independent claims 30, 15, 22, or 26 (which have been distinguished from the cited art above), and accordingly it is submitted that the rejection of claims 21, 29 and 32 has been traversed by virtue of their dependency from one of independent claims 30, 15, 22, or 26. See M.P.E.P. § 2143.03.

### **Conclusion**

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of claims 9, 15 and 21-32 at an early date is solicited. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

October 22, 2008

Date



Peter R. Martinez  
Attorney for Applicant(s)  
Reg. No. 42,845